

TAUCH ET AL. -- 09/704,725  
Client/Matter: 021123-0274355

## **II. REMARKS**

### **Preliminary Remarks**

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 17, 20, 23, and 26-29 have been allowed. Claims 2, 6, 15, 16, 21, 22, 24, and 25 remain at issue.

On page 2 of the official action, claims 18 and 33 were objected to by the examiner for being dependent upon rejected claim 2. Claims 18 and 33 are now believed to dependent upon an allowable claim 2 and thus request withdrawal of the rejection.

The applicants do not intend by these or any amendments to abandon subject matter of the claims as originally filed or later presented, and reserve the right to pursue such subject matter in continuing applications.

### **Patentability Remarks**

#### ***Rejection Under 35 U.S.C. §101***

On page 2 of the official action, the examiner rejected claims 6, 15, and 16 under 35 U.S.C. §101 for allegedly being directed to non-statutory subject matter. Specifically, the examiner alleged that these claims are directed to naturally occurring plasmids, which are considered to be non-statutory subject matter and show the absence of the hand of man.

The applicants believe this rejection is also directed to claim 2 due to the examiner's objection of claims 18 and 33. Accordingly, the applicants have adopted the examiner's suggestion and inserted the phrase "An isolated and purified plasmid" in amended claims 2, 6, 15, and 16 to reflect the hand of man. In view of the foregoing amendments, the rejection of claims 2, 6, 15, and 16 under 35 U.S.C. §101 has been overcome and should be withdrawn.

#### ***Rejections Under 35 U.S.C. §112, Second Paragraph, Indefiniteness***

On page 3 of the official action, the examiner rejected claims 21, 22, 24, and 25 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. Specifically, the examiner asserted claims 24 and 25 are indefinite because these claims are drawn to the plasmid pCRY4 and attempt to add limitations onto a specific plasmid. The examiner asserted claims which are drawn to the plasmid pCRY4 of claim 23 are either improperly dependent or

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duplicative of claim 23 since plasmid pCRY4 cannot be modified. In addition, the examiner asserted the limitations of claims 24 and 25 are inherently present in the plasmid pCRY4 and are thus duplicates of claim 23. The examiner asserted claim 24 is further indefinite because some of the limitations of this claim appear to be specific for both pCRY4 (limitation i) and pTET3 (limitation iii) which appears to describe a plasmid other than plasmid pCRY4 but does not further limit the plasmid pCRY4. The examiner alleged claims 21 and 22 are similarly indefinite as claims 24 and 25 in that each claim (claims 21 and 22) is directed to the plasmid pTET3 of claim 20. In view of the amendments and following remarks, the applicants respectfully traverse this indefiniteness rejection.

Solely for the purpose of expediting prosecution, and without prejudice to the applicants' right to seek broader claims in a continuing application, the applicants have canceled claim 24 without prejudice, thereby obviating the rejection of this claim. Amended claim 21 is directed to the plasmid pTET3 of claim 20, wherein said plasmid is compatible with plasmid pCRY4. Amended claim 22 is directed to the plasmid of pTET3 of claim 20, wherein said plasmid is compatible with one or more of the plasmids selected from the group consisting of pGA1, pGA2, pAG3, pBL1, and pHM1519. Amended claim 25 is directed to the isolated plasmid pCRY4 of claim 23, wherein said plasmid is compatible with one or more of the plasmids selected from the group consisting of pGA1, pGA2, pAG3, pBL1, and pHM1519. Support for amended claims 21, 22, and 25 can be found throughout the specification, for example, on page 2, lines 25-30; page 5, lines 25-30; page 14, lines 12-14; and page 14, line 25 to page 15, line 7.

The applicants hereby submit that claims 21, 25, and 26 are no longer improperly dependent or duplicative of the claimed subject matter of claims 20 and 23. Specifically, claims 21, 25, and 26 are either directed to the compatibility of plasmids pTET3 and pCRY4 to each other or with plasmids from the group consisting of pGA1, pGA2, pAG3, pBL1, and pHM1519. In view of the foregoing amendments and remarks, the applicants submit that the rejection of claims 21, 22, 24, and 25 under 35 U.S.C. §112, second paragraph, for alleged lack of indefiniteness, has been overcome and should be withdrawn.

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### III. CONCLUSION

In view of the foregoing, the claims are now believed to be in form for allowance, and such action is hereby solicited. If any point remains at issue which the examiner feels may be best resolved through a personal or telephone interview, please contact the undersigned at the telephone number listed below.

Respectfully submitted,  
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